Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT M. SCALLIET and
RAYMOND R. RUTH

Appeal No. 94-3184
Application 07/924,828[1]

ON BRIEF

Before CAROFF, JOHN D. SMITH and HANLON, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 5 and 6, all of the claims pending in the application. Claim 5 is illustrative of the subject matter on appeal and reads as follows:

5. A composition for use as a fuel comprising:

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[1] Application for patent filed August 4, 1992.

from about 3 to about 10% by weight water;

greater than about 35% by weight solids, said solids comprising inorganic solids and combustible organic solids that are insoluble in methylene chloride;

from about 30 to about 70% by weight of liquid hydrocarbons, the composition having a minimum heat value of at least about 7,000 BTU's per pound and viscosity such that said composition is a pumpable fluid at ambient temperature, said solids and said liquid hydrocarbons being obtained from the same refinery waste stream containing liquid hydrocarbons, water and said solids whereby all of the heat value of said composition is derived from components initially present in said waste stream.

The references relied upon by the examiner are:

Battista	4,358,292	Nov. 9, 1982
Verhille	4,842,616	Jun. 27, 1989
Chu	5,141,526	Aug. 25, 1992

The following rejections are at issue in this appeal:

(1) Claim 5[2] is rejected under 35 U.S.C. § 112, first paragraph, “written description requirement”;

(2) Claim 5[3] is rejected under 35 U.S.C. § 112, second paragraph;

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[2] Claim 6 has not been rejected by the examiner. However, since claim 6 depends from claim 5, it properly should have been included in this rejection. See 37 CFR § 1.75(c). The omission of claim 6 from the rejection appears to have been an oversight by the examiner. Nevertheless, in any subsequent prosecution, a rejection of claim 5 under 35 U.S.C. § 112, first paragraph, should also include dependent claim 6.

[3] See footnote 2.

(3) Claims 5 and 6 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Chu;

(4) Claims 5 and 6 are rejected under 35 U.S.C. § 103 as being unpatentable over Battista in view of Verhille.

Grouping of claims

The examiner's answer indicates that (Answer, p.2):

> Appellant's brief includes a statement that claims 5 and 6 do not stand or fall together and provides reasons as set forth in 37 C.F.R. § 1.192(c)(5) and (c)(6).

However, appellants in their brief expressly state that "[f]or purposes of this Appeal, Claims 5 and 6 can be grouped to stand or fall together" (Brief, p.3). Furthermore, appellants have failed to explain why claim 6 is believed to be separately patentable over claim 5. See 37 CFR § 1.192(c)(7). Therefore, for purposes of this appeal, claim 6 stands or falls with the patentability of independent claim 5.

Rejection under 35 U.S.C. § 112, first paragraph

Claim 5 is rejected under 35 U.S.C. § 112, first paragraph, “written description requirement”. According to the examiner,

the specification, as originally filed, fails to provide support for a critical range of “3 to about 10% by weight water” recited in claim 5. We affirm the rejection.

Claim 5 recites a composition for use as a fuel comprising "from about 3 to about 10% by weight water." The specification states (p.3, lines 21-23):

> Generally speaking, the water will be present in an amount of less than about 10 percent-by-weight, more preferably in the range of from about 3 to about 8 percent-by-weight. [Emphasis added.]

The claim recites an upper limit of "about 10% by weight water." However, the specification expressly states that water is present in an amount of "less than about 10 percent-by-weight" (emphasis added). Therefore, we agree with the examiner that there is no support for the upper limit of "about 10% by weight water" recited in claim 5. We note that appellants were willing to amend claim 5 to obviate this rejection. In an amendment filed under 37 CFR § 1.116(a), appellants proposed to amend claim 5 with the language of "less than about 10% down to about 3% by weight water" (paper no. 7). However, the examiner did not enter the amendment to claim 5 (paper no. 8).

We agree with appellants that the specification supports the lower limit of "about 3 . . .% by weight water" recited in claim 5. The specification expressly states that "water will be present in an amount . . . preferably in the range of from about 3 to about 8 percent-by-weight" (emphasis added). The examiner has failed to establish that the broadly described range of "less than about 10 percent-by-weight" water defines a different invention than a composition defined by claim 5 having at least "about 3 . . . % by weight water."[4] See In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) ("in light of the description of the invention as employing solids contents within the range of 25-60% along with specific embodiments of 36% and 50%, we are of the opinion that, as a factual matter, persons skilled in the art would consider processes employing a 35-60% solids content range to be part of appellants' invention").

Rejection under 35 U.S.C. § 112, second paragraph

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The examiner maintains that the phrase

[4] It would appear that the examiner also agrees that the specification provides support for the lower limit claimed. See Answer, p.5 ("However, the Examiner maintain the position that appellant has basis for the critical range of '3 to 8% by weight water' and a range for less than 10% by weight water'. However, there is not support for the upper 10% range.").

"being obtained" is not recited in a positive manner and suggests that the word "being" be replaced with the word "are."[5]

We agree with appellants that the examiner's position is a semantical argument. One of ordinary skill in the art reading claim 5 would understand that the solids and liquid hydrocarbons of the claimed composition are obtained from the same source (i.e., refinery waste stream) which initially contains liquid hydrocarbons, water and solids. The fact that the examiner may be of the opinion that there is more suitable language to define the claimed invention is not a proper basis for a rejection under 35 U.S.C. § 112, second paragraph.

Prior art rejections

Claim 5 is drawn to a composition for use as a fuel comprising specific ranges of water, solids and liquid hydrocarbons. The composition has a viscosity such that it is a pumpable fluid at ambient temperature. Furthermore, the solids and liquid hydrocarbons of the claimed composition are obtained from the same source (i.e., refinery waste stream) which contains

[5] Appellants also proposed an amendment to claim 5 to obviate this rejection in the same amendment under 37 CFR § 1.116(a) referred to in the previous section (paper no. 7). However, as pointed out above, the examiner did not enter the amendment to claim 5 (paper no. 8).

liquid hydrocarbons, water and solids whereby all of the heat value of the composition is derived from components initially present in that source.

A. Rejection under 35 U.S.C. § 102(b)

Claims 5 and 6 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Chu. We reverse this rejection.

Chu discloses a fuel composition comprising water, solids, oil and a filter aid. Arguably one can extract appellants' claimed composition ranges[6] from the ranges disclosed in Chu, see specifically col. 4, lines 45-54 (Brief, p.6). However, the composition of claim 5 also contains the following limitations not taught or suggested in Chu:

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[6] We note that the examiner has made several rejections under 35 U.S.C. § 112. However, the examiner has not rejected claims 5 and 6 under 35 U.S.C. § 112, second paragraph, as being indefinite for claiming a composition having mathematically incorrect ranges of components. A composition falling within the scope of claim 5 comprising liquid hydrocarbons in an amount equal to or greater than 62% by weight would result in a composition comprising components totaling in excess of 100% by weight, a mathematical impossibility.

We note that the examiner made a similar rejection of claim 1 in the Office action dated January 4, 1993 (paper no. 4), wherein the examiner stated:

> . . . the "30 to about 70 percent-by-weight combustible" would not provide for the inclusion of water, nor greater than 35 percent solids when the upper range of 70 percent liquid is used because it would total to greater than 100 percent composition.

In response to this Office action, appellants canceled claims 1-4 and added new claims 5 and 6 (paper no. 5). However, contrary to appellants' remarks and failure to comment on the above-noted rejection, the cancellation of claims 1-4 and submission of newly added claims 5 and 6 do not appear to have corrected this deficiency. In any subsequent prosecution, the examiner should consider whether a rejection of claims 5 and 6 under 35 U.S.C. § 112, second paragraph, based on the above-identified grounds is proper.

(1) a viscosity such that the composition is a pumpable fluid at ambient temperature;

(2) the solids and liquid hydrocarbons of the composition are obtained from the same refinery waste stream which contains liquid hydrocarbons, water and solids whereby all of the heat value of the composition, a minimum of at least about 7,000 BTU's per pound, is derived from components initially present in the waste stream.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros., Inc. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The fuel disclosed in Chu is not a "pumpable fluid" as required by appellants' claims. Rather, Chu teaches that the fuel preparation disclosed is a "solid fuel" (col. 1, lines 64-66; col. 2, lines 13-24) and refers to the fuel as a "filter cake" throughout the specification (see for example, col. 2, line 30). Furthermore, Chu teaches that a filter aid having a heating value of at least 1,000 Btu/lb is ADDED to the waste sludge to increase the heating value of the filter cake

(col. 2, lines 3-8, 29-33 and 50-54). Therefore, we conclude that Chu fails to anticipate claim 5.

B. Rejection under 35 U.S.C. § 103

Claims 5 and 6 are rejected under 35 U.S.C. § 103 as being unpatentable over Battista in view of Verhille. We also reverse this rejection.

Battista discloses a fuel slurry comprising water, liquid fuel oil and solid fuel particles. The examiner recognizes that the Battista reference "lacks specific teachings to inorganic solids and all of the composition from the same source" (Answer, p.4). Furthermore, the examiner states that she (Answer, p.7):

> [A]grees with appellant's arguments that Battista does not teach that the total heat capacity of the composition is derived from the same refinery waste stream . . . .

The examiner relies on Verhille for the deficiencies in Battista and concludes that the claimed invention would have been prima facie obvious (Answer, pp.4-5):

> . . . Verhille teaches a similar fuel composition comprising a mixture of aqueous residual liquids with oily combustible materials comprising organic solids and inorganic solids (col. 4, lines 35-54 and claims 1, 12-16 and 19-21). Having the prior art before him it would have been obvious to

> the artisan in the fuel art that Battista fuel composition inherently have inorganic solids, e.g. ash, metallic particles from the engine, etc present in its waste crank oil. Verhille teaches Battista's teachings that organic and inorganic solids are conventional found in refinery waste slurries, as well as, water and hydrocarbon oils provides the motivation to the artisan in the art to use a composition from the same source as Battista's hybrid fuel composition to render the claims prima facie obvious.

The examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. § 103. As pointed out above, the claim requires that the solids and liquid hydrocarbons of the composition be obtained from the same refinery waste stream which contains liquid hydrocarbons, water and solids whereby all of the heat value of the composition is derived from components initially present in the waste stream.

We agree with appellants that neither Battista nor Verhille teach or suggest this limitation. Furthermore, the fact that the fuel composition disclosed in Verhille may contain inorganic solids is of no moment since the components of the fuel composition disclosed in Verhille are not obtained from the same refinery waste stream. Therefore, the teachings in Verhille do not make up for the deficiencies in the Battista reference.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

MARC L. CAROFF Administrative Patent Judge	)
JOHN D. SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
ADRIENE LEPIANE HANLON Administrative Patent Judge	)

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